

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT D. MAHONEY, JIRO KAWAMOTO, RICHARD A. LUNDGARD,  
MARK F. SONNENSCHNEIN, HAWK S. WAN and H. NELSON BECK

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Appeal No. 95-4970  
Application No. 08/012,872<sup>1</sup>

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ON BRIEF

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Before KIMLIN, GARRIS and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-21 and 23-39, all the claims remaining in the present application. Claim 1 is illustrative:

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<sup>1</sup> Application for patent filed February 3, 1993. According to appellants, this application is a continuation-in-part of Application No. 07/746,756, filed August 19, 1991, now U.S. Patent No. 5,246,647, issued September 21, 1993; which is a continuation-in-part of Application No. 07/329,666, filed March 28, 1989, now U.S. Patent No. 5,043,112, issued August 27, 1991.

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1. A process for preparing a microporous membrane from a poly(phenylene sulfide) polymer comprising the steps of:

A. forming a mixture comprising:

(i) at least one poly(phenylene sulfide) polymer,

(ii) at least one amorphous polymer which is substantially stable at elevated temperatures, which possesses a glass transition temperature of at least about -100EC, and wherein said amorphous polymer is at least partially immiscible in said poly(phenylene sulfide) polymer at ambient conditions; and

(iii) optionally a plasticizer comprising at least one organic compound capable of dissolving at least about 10 weight percent of said poly(phenylene sulfide) polymer at the extrusion or casting temperature;

B. heating the mixture to a temperature at which said mixture becomes a fluid;

C. extruding or casting said fluid under conditions such that a membrane is formed;

D. subjecting said membrane to controlled cooling or coagulation by passing said membrane through at least one zone under conditions such that said membrane solidifies;

E. leaching said membrane by passing said membrane through at least one zone under conditions such that at least a portion of said optional plasticizer for said poly(phenylene sulfide) polymer, at least a portion of said amorphous polymer, or a combination thereof, is removed from said membrane; and

F. producing a final microporous membrane.

The examiner relies upon the following references as evidence of obviousness:

Beck	5,043,112	Aug. 27, 1991
Damrow et al. (Damrow)	5,205,968	Apr. 27, 1993

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Appellants' claimed invention is directed to a process for making a microporous membrane from a poly(phenylene sulfide) polymer.

Appealed claims 1-21 and 23-39 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,205,968 in view of Beck. In addition, claims 1-21 and 23-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Damrow in view of Beck.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections. Our reason for not sustaining either of the examiner's rejections is the same, i.e., the patent to Beck is not prior art.

The present application is a continuation-in-part of U.S. Application No. 07/746,756, now U.S. Patent No. 5,246,647, which, in turn, is a continuation-in-part of U.S. Application No. 07/329,666, now U.S. Patent No. 5,043,112 (the Beck patent relied upon by the examiner as prior art). Since the application on appeal incorporates by reference the subject matter of the parent application (U.S. Patent No. 5,246,647), and said parent application incorporates by reference in its entirety the grandparent of the present application (U.S. Patent No. 5,043,112), it cannot

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be gainsaid that the entire specification of U.S. Patent No. 5,043,112 is part of the original specification of the present application on appeal. Manifestly, the specification of an application is not prior art to the same application. Accordingly, the examiner errs in stating that the subject matter regarding the equivalence of PPS and PEEK materials, which is disclosed in U.S. Patent No. 5,043,112, is not disclosed in U.S. Patent No. 5,246,647 and in the present application.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
BRADLEY R. GARRIS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
CHUNG K. PAK	)	
Administrative Patent Judge	)	

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